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PATENT
Attorney Docket No. P2048US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael A. Arkes

Application No. 09/414,951

Art Unit: 2164

Filed: October 8, 1999

Examiner: Charles R. Kyle

For: An Incentive Points Redemption
Program Carried Out Via
An On-Line Auction

DECLARATION UNDER 37 C.F.R. § 1.131

I, the undersigned, hereby declare the following:

1. I am the named inventor and have personal knowledge of the facts concerning conception and completion of at least certain of the claimed inventive subject matter of the above-captioned patent application.

2. In the course of my tenure at Hinda, Inc., I was closely involved with the development of an On-Line Incentive Points Redemption Program.

3. Exhibits A-Y provide the following information representative of functionality of the on-line auction system as it existed prior to July 14, 1999:

Exhibit A is a redacted copy of a customer requirements catalog created prior to July 14, 1999, outlining desired features of the software for operating an on-line auction for an Incentive Points Redemption Program. At least those features of

the on-line auction discussed in more detail below in paragraphs 4 and 5 of this Declaration were reduced to practice in the United States of America prior to July 14, 1999;

Exhibit B includes redacted copies of screen shots illustrating details of an on-line accessible check-out form that enables a participant to purchase an item as opposed to bidding on an item during an auction;

Exhibit C includes redacted copies of screen shots illustrating an example of code for an on-line bid summary form for the on-line auction;

Exhibit D includes redacted copies of screen shots illustrating an example of code for an auction index form for the on-line auction;

Exhibit E includes redacted copies of screen shots illustrating an example of an auction item set-up form for selecting an item for bidding for the on-line auction;

Exhibit F includes redacted copies of screen shots illustrating an example of a form for indicating items in the auction house that can be auctioned in the on-line auction;

Exhibit G includes redacted copies of screen shots illustrating an example of a form for indicating auction bid summaries occurring during an on-line auction;

Exhibit H includes redacted copies of screen shots illustrating an example of a shopping cart form that can be used to purchase items in the auction house;

Exhibit I includes redacted copies of screen shots illustrating an example of welcome screen forms for an auction participant;

Exhibit J includes redacted copies of screen shots illustrating an example of code for a view template for an auction index;

Exhibit K includes redacted copies of screen shots illustrating an example of code and a form for indicating an auction item index;

Exhibit L includes redacted copies of screen shots illustrating an example of a view template for a winners' circle and a listing of winners for a particular item in the on-line auction;

Exhibit M includes redacted copies of screen shots illustrating an example of code for a web auction item form;

Exhibit N includes redacted copies of screen shots illustrating an example of code for an auction bid form;

Exhibit O includes redacted copies of screen shots illustrating an example of code and a web item bid form for an on-line auction;

Exhibit P includes redacted copies of screen shots illustrating an example of code and an item form for an on-line auction;

Exhibit Q includes redacted copies of screen shots illustrating an example of a bid history in points for an on-line auction;

Exhibit R includes redacted copies of screen shots illustrating an example of a shopping cart form for purchasing items;

Exhibit S includes redacted copies of screen shots illustrating an example of a winner circle index for on-line auctions;

Exhibit T includes redacted copies of screen shots including an example of a screen for listing all items for an on-line auction;

Exhibit U includes redacted copies of screen shots including an example of a screen shot for listing auction items for an on-line auction;

Exhibit V includes redacted copies of screen shots including an example of a screen shot for listing auction items for an on-line auction;

Exhibit W includes redacted copies of screen shots including an example of a screen shot for listing bid summaries from an on-line auction;

Exhibit X includes redacted copies of screen shots including an example of a screen shot for listing auction items; and

Exhibit Y includes redacted copies of screen shots including an example of a screen shot for indicating auction items for an on-line auction.

4. As evidenced in Sections 2 and 6 on pages 3 and 5, respectively, of Exhibit A, the functional requirements include an Incentive Points Redemption Program that allows participation in a web-based on-line auction. The screen shots in Exhibits B-Y also collectively illustrate the ability to perform such an on-line auction and are representative of the functionality of the on-line auction system as it existed prior to July 14, 1999. As evidenced in Section 6.8 on page 5 of Exhibit A and in the screen shots shown in Exhibits E & F, the on-line auction system prior to July 14, 1999 was capable of designating a set of auction items from a catalog of potential auction items, their respective suggested price or points value, and providing on-line bid access to the set of auction items. A participant was permitted by the on-line auction system to retrieve data corresponding to an item including the description of an item, a suggested opening bid and data relating to a current bid as evidenced in the screen shots of Exhibits Q and W. The screen shots shown in Exhibits L, Q, S and W further illustrate that prior to July 14, 1999, the on-line auction system had the capability of determining whether a new bid exceeds a

point value, while maintaining a high bid for each item and identifying, upon the ending of an auction period, a participant corresponding to the highest bid for the item.

5. As further evidenced in Exhibit L, the system had the capability prior to July 14, 1999 to notify the participant of the highest bid, and such notification could have been made via e-mail. As evidenced in Sections 3 and 4 of Exhibit A and in Exhibit I, the on-line auction system prior to July 14, 1999 enabled a participant to submit delivery address and additional information to identify the participant so that the system could determine if the participant was authorized to participate in the auction, and so that the item the participant won in the auction could be delivered to the participant. As evidenced in Section 5 of Exhibit A, prior to July 14, 1999, the on-line auction system had the capability of adjusting the winning participant's points after the bidding was completed and the participant won the item.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.

Date:

October 7, 2004

Michael A. Arkes

Michael A. Arkes

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Web based Catalog Requirements

Draft

Introduction

Corporation has requested that In Marketing provide services to implement and maintain a web based points management system and web based points redemption catalogs. In Marketing has partnered with Hinda Incentives to provide the functionality described below.

This document will serve to detail the functions required of the system.

Overall Design

will be offering an incentive program to their sales channels. Hinda will present the awards catalog with points redemption pricing, shopping cart functions and points balance / statement viewing functions. Participants will receive points based on product serial number/model number identification. Hinda will provide reporting views of placements for each participant. Hinda will provide enrollment and placement data entry interfaces for participants.

Hinda will provide a sweepstakes program within the incentive program. Hinda will provide an Auction House and an online club divided by volume groups.

Points balances, participant data, program rules, award structures, new product announcements and administrator updates will be performed via Hinda's System Management Utility by administrators and administrators.

An estimated 2600 users will start with the program.

Functional Requirements

1.0 Front End pages

- 1.1 Welcome page will present authentication. All others pages will be secured.
- 1.2 Welcome page will be linked from _____ and _____ web sites.

2.0 Web-based Points Redemption Catalog

- 2.1 _____ incentive program participants will be allowed to logon to and view the catalog, selecting items for points redemption. These items will be compiled in a "shopping cart" which will track and calculate their redemptions.
- 2.2 Catalog Items – AC6 catalog _____ products, w/o competitor product.
- 2.3 Points accumulation will take place upon verification, by _____ of product invoices against participant-entered placements.
- 2.4 Duplicate placements will be rejected, and logged, appearing on the reports as non-approved placements.
- 2.5 Participants will be allowed to view their points balance and statement activities, including a record of verified placements, points earnings and redemptions.
- 2.6 Participants will be allowed to view a "Top Ten" rankings page for each program. Participants will be limited to viewing only top ten lists for their program.
- 2.7 A sweepstakes will draw 100 participants monthly from the placement database, with 99 winners receiving a pre-selected points award amount, and 1 winner receiving a choice from established travel awards.

3.0 Enrollment

- 3.1 Participants will be allowed to self enroll and be required to
Or – Sales managers will link themselves to salespersons and dealers.
 - 3.1.1 Associate themselves to sales managers
 - 3.1.2 Associate themselves to Dealers
- 3.2 Participants will be issued a unique security code based on their dealer number and the last four digits of their social security number
Or – _____ will provide a list of the current passwords.
- 3.3 Sales manager participants will be given additional management logon ids. Sales managers will earn an override on sales persons.

4.0 Placement Entry

- 4.1 Participants will be allowed to enter sales for placement. Entry will include:
 - 4.1.1 User name
 - 4.1.2 Password
 - 4.1.3 Product description
 - 4.1.4 Model number – to be included with serial number for unique identifier.
 - 4.1.5 Serial number
 - 4.1.6 Serial number will be identical if manufactured on same day. Model number will be differentiator
 - 4.1.7 Serial number will be 9 or 10 digits, 1 = year, 9 = month, with X=OCT, Y=NOV, Z=DEC.
 - 4.1.8 Placements will be verified or rejected by In Marketing.
 - 4.1.9 Placements will be displayed to participants in a statement.
- 5.0 **Administration Tasks**
 - 5.1 Administrators will use the System Management Utility to perform the following tasks:
 - 5.1.1 Points Database updates
 - 5.1.1.1 Batch updates
 - 5.1.1.2 Individual updates
 - 5.1.2 View Reports
 - 5.2 The administration utility will include encryption of the batch files, and secure access to the database for administration.
 - 5.3 Administrators will have the ability to update the points database, based on an admin access control table. This table will allow for individual or group access control lists, which specify tasks each administrator or group is authorized to performed. Access Control Lists will include:
 - 5.3.1 Salesperson – no admin rights.
 - 5.3.2 Sales Manager -
 - 5.3.3 Dealer – view data only
 - 5.3.4 Sharp Regional Manager – overview of his region – report only
 - 5.3.5 In Marketing Admin
 - 5.4 Administrators will have the ability to modify program rules.
 - 5.5 Administrators will have the ability to modify award structures.
 - 5.6 Administrators will have the ability to create new product announcements.
 - 5.7 Administrators will have the ability to view placements and verifications by participant, sales manager and dealer.
 - 5.8 Reports - Administrators will have the ability to report based on the following criteria:
 - 5.8.1 Points transactions
 - 5.8.1.1 Points verified and awarded
 - 5.8.1.2 Points unverified
 - 5.8.2 Activity by month
 - 5.8.3 Activity by Business Segment
 - 5.8.4 Activity by Participant
 - 5.8.5 Participant Statement
 - 5.8.6 Rankings
 - 5.8.7 Total points earned
 - 5.8.8 Total points redeemed

- 5.8.9 Total points remaining
- 5.8.10 Billing detail
- 5.8.11 Sales by model
- 5.8.12 Sales by customer
- 5.8.13 Sales by dealer
- 5.8.14 Awards redemptions
- 5.8.15 1099 based on awards redemptions
- 5.9 In Marketing Admin interface – Hinda will provide an interface to view unverified placements, verified placements and rejected placements.
 - 5.9.1 will be allowed to perform verification of placements according to their criteria, and update the Hinda placement database.
 - 5.9.2 Description on placements will include date, time, user and model/serial numbers.
- 5.10 invoicing – Hinda will invoice on behalf of
 - 5.10.1 Hinda will include markup to
 - 5.10.2 will pay into a lockbox.
 - 5.10.3 Hinda will pay In Marketing the difference.
- 5.11 interface – orders for award products will go to for order fulfillment. Hinda will interface with:
 - 5.11.1 Provide PO for orders to be shipped
 - 5.11.2 Capture confirmation of shipment by
 - 5.11.3 Provide customer service tracing
 - 5.11.4 Provide invoicing from Hinda
- 6.0 Auction House**
 - 6.1 Participants will be given the ability to use points to bid on merchandise or travel items in quarterly auctions.
 - 6.2 Auctions will be announced on web site, and I web site.
- 7.0 On-line Club**
 - 7.1 Online clubs will be offered to top performing participants
 - 7.2 Top 10% will be offered membership
 - 7.3 Four volume groups will be established.
 - 7.4 Members earn double points on placements for the first month after induction, and after each month they retain their membership.
 - 7.5 At fiscal end, the top 10% of participants in each group earn a 25% bonus on all points earned during the next fiscal.
- 8.0 Security**
 - 8.1 Administration - Hinda's System Management Utility will provide end to end security for administration tasks, including administrator access control, data encryption and data verification.

Item	Description	Quantity	Unit	Estimate	Comments	Notes
1	Copy of Item Bid	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
2	Copy of Welcome	1	Each	07/14/1999 12:25:50 AM	Ben-Michalski/HIRDA	
3	Copy of \$500,000 multiple for Auction Ind	1	Each	06/06/1999 01:05:38 PM	Jennings/HIRDA	
4	Copy of \$500,000 multiple for Welcome	1	Each	07/12/2000 05:15:54 PM	Circle-Jennings/HIRDA	
5	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
6	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
7	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
8	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
9	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
10	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
11	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
12	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
13	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
14	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
15	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
16	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
17	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
18	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
19	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
20	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
21	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
22	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
23	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
24	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
25	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
26	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
27	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
28	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
29	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
30	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
31	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
32	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
33	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
34	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
35	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
36	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
37	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
38	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
39	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
40	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
41	Item Bid	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
42	Shopping Cart	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
43	Welcome	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	
44	\$500,000 multiple for Auction Ind	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
45	\$500,000 multiple for For Sale Item	1	Each	07/12/2000 05:05:00 PM	Circle-Jennings/HIRDA	
46	\$500,000 multiple for Welcome	1	Each	07/15/1999 11:04:10 AM	Ben-Michalski/HIRDA	
47	For Sale Item	1	Each	06/07/1999 11:25:19 AM	Michael D'Connor/Chilworth	

Auction House Bid Summary									
Bid Information Term: <input type="text"/> Rep Auction: <input type="text"/> Rep Auction Number: <input type="text"/> Rep Auction Item: <input type="text"/> WF Hnd Shu: <input type="text"/>									
Shipping Information <i>Key: Y=Yes, N=No, S=Ship by mail, P=Prepaid</i> Name: <input type="text"/> S Name: <input type="text"/> Company: <input type="text"/> S Company: <input type="text"/> Address: <input type="text"/> S Address: <input type="text"/> Address 1: <input type="text"/> S Address 1: <input type="text"/> City: <input type="text"/> S City: <input type="text"/> State: <input type="text"/> S State: <input type="text"/> Zip: <input type="text"/> S Zip: <input type="text"/> Phone: <input type="text"/> S Phone: <input type="text"/> E Mail: <input type="text"/> S E Mail: <input type="text"/>									
Payment Information Name: <input type="text"/> Company: <input type="text"/> Address: <input type="text"/> Address 1: <input type="text"/> City: <input type="text"/> State: <input type="text"/> Zip: <input type="text"/> Phone: <input type="text"/> E Mail: <input type="text"/>									
Account Information Account Type: <input type="text"/> Account: <input type="text"/> PG Number: <input type="text"/> PO Number: <input type="text"/> Credit Card: <input type="text"/> Credit Card: <input type="text"/> Card Number: <input type="text"/> Card Number: <input type="text"/> Expiration: <input type="text"/> Expiration: <input type="text"/>									

Auction Design - Items - Initial Items Design

FOR THE SALE OF THE FOLLOWING ITEMS, THE AUCTIONEER HAS BEEN INSTRUCTED TO ACCEPT BIDS FROM ALL BIDDERS WHOSE BIDS ARE RECEIVED BY THE AUCTIONEER ON OR BEFORE THE CLOSING DATE AND TIME SPECIFIED BELOW.

Item	Description	Start Date/Time	End Date/Time	Accepted Bids	Accepted Bids	Accepted Bids
200	Check Out	06/07/1999 11:28:18 AM	06/07/1999 11:28:18 AM	Michael O'Connor/Chilton		
201	CHOKA-55000 Template for Auction Info	01/12/2000 05:05:03 PM	01/12/2000 05:05:03 PM	Cris Jennings/HQDA		
202	Copy Of Welcome	07/14/1999 10:25:59 AM	07/14/1999 10:25:59 AM	Ben Michael/HQDA		
203	Copy Of 55000 Template for Auction Info	06/07/1999 01:05:36 PM	06/07/1999 01:05:36 PM	Jackie Rodriguez/O'Connor		
204	Copy Of 55000 Template for Auction Info	01/12/2000 05:10:54 PM	01/12/2000 05:10:54 PM	Cris Jennings/HQDA		
205	For Sale Item	06/07/1999 11:28:15 AM	06/07/1999 11:28:15 AM	Michael O'Connor/Chilton		
206	Item Bid	06/07/1999 11:28:18 AM	06/07/1999 11:28:18 AM	Michael O'Connor/Chilton		
207	Shipping Cost	07/14/1999 10:25:59 AM	07/14/1999 10:25:59 AM	Ben Michael/HQDA		
208	Welcome	07/14/1999 10:25:59 AM	07/14/1999 10:25:59 AM	Ben Michael/HQDA		
209	55000 Template for Auction Info	01/12/2000 05:10:54 PM	01/12/2000 05:10:54 PM	Cris Jennings/HQDA		
210	55000 Template for Auction Info	07/14/1999 10:25:59 AM	07/14/1999 10:25:59 AM	Ben Michael/HQDA		
211	55000 Template for Auction Info	01/12/2000 05:10:54 PM	01/12/2000 05:10:54 PM	Cris Jennings/HQDA		
212	55000 Template for Auction Info	07/14/1999 10:25:59 AM	07/14/1999 10:25:59 AM	Ben Michael/HQDA		
213	Web Item Bidding	06/07/1999 11:28:15 AM	06/07/1999 11:28:15 AM	Michael O'Connor/Chilton		
214	Web Item Bidding	06/07/1999 11:28:18 AM	06/07/1999 11:28:18 AM	Michael O'Connor/Chilton		
215	Web Item Bidding	01/12/2000 05:10:54 PM	01/12/2000 05:10:54 PM	Cris Jennings/HQDA		
216	Web Item Bidding	01/12/2000 05:10:54 PM	01/12/2000 05:10:54 PM	Cris Jennings/HQDA		

Item Details

Item: 200
Description: Check Out
Start Date/Time: 06/07/1999 11:28:18 AM
End Date/Time: 06/07/1999 11:28:18 AM
Accepted Bids: Michael O'Connor/Chilton

Item Details

Item: 201
Description: CHOKA-55000 Template for Auction Info
Start Date/Time: 01/12/2000 05:05:03 PM
End Date/Time: 01/12/2000 05:05:03 PM
Accepted Bids: Cris Jennings/HQDA

Item Details

Item: 202
Description: Copy Of Welcome
Start Date/Time: 07/14/1999 10:25:59 AM
End Date/Time: 07/14/1999 10:25:59 AM
Accepted Bids: Ben Michael/HQDA

Item Details

Item: 203
Description: Copy Of 55000 Template for Auction Info
Start Date/Time: 06/07/1999 01:05:36 PM
End Date/Time: 06/07/1999 01:05:36 PM
Accepted Bids: Jackie Rodriguez/O'Connor

Item Details

Item: 204
Description: Copy Of 55000 Template for Auction Info
Start Date/Time: 01/12/2000 05:10:54 PM
End Date/Time: 01/12/2000 05:10:54 PM
Accepted Bids: Cris Jennings/HQDA

Item Details

Item: 205
Description: For Sale Item
Start Date/Time: 06/07/1999 11:28:15 AM
End Date/Time: 06/07/1999 11:28:15 AM
Accepted Bids: Michael O'Connor/Chilton

Item Details

Item: 206
Description: Item Bid
Start Date/Time: 06/07/1999 11:28:18 AM
End Date/Time: 06/07/1999 11:28:18 AM
Accepted Bids: Michael O'Connor/Chilton

Item Details

Item: 207
Description: Shipping Cost
Start Date/Time: 07/14/1999 10:25:59 AM
End Date/Time: 07/14/1999 10:25:59 AM
Accepted Bids: Ben Michael/HQDA

Item Details

Item: 208
Description: Welcome
Start Date/Time: 07/14/1999 10:25:59 AM
End Date/Time: 07/14/1999 10:25:59 AM
Accepted Bids: Ben Michael/HQDA

Item Details

Item: 209
Description: 55000 Template for Auction Info
Start Date/Time: 01/12/2000 05:10:54 PM
End Date/Time: 01/12/2000 05:10:54 PM
Accepted Bids: Cris Jennings/HQDA

Item Details

Item: 210
Description: 55000 Template for Auction Info
Start Date/Time: 07/14/1999 10:25:59 AM
End Date/Time: 07/14/1999 10:25:59 AM
Accepted Bids: Ben Michael/HQDA

Item Details

Item: 211
Description: 55000 Template for Auction Info
Start Date/Time: 01/12/2000 05:10:54 PM
End Date/Time: 01/12/2000 05:10:54 PM
Accepted Bids: Cris Jennings/HQDA

Item Details

Item: 212
Description: 55000 Template for Auction Info
Start Date/Time: 07/14/1999 10:25:59 AM
End Date/Time: 07/14/1999 10:25:59 AM
Accepted Bids: Ben Michael/HQDA

Item Details

Item: 213
Description: Web Item Bidding
Start Date/Time: 06/07/1999 11:28:15 AM
End Date/Time: 06/07/1999 11:28:15 AM
Accepted Bids: Michael O'Connor/Chilton

Item Details

Item: 214
Description: Web Item Bidding
Start Date/Time: 06/07/1999 11:28:18 AM
End Date/Time: 06/07/1999 11:28:18 AM
Accepted Bids: Michael O'Connor/Chilton

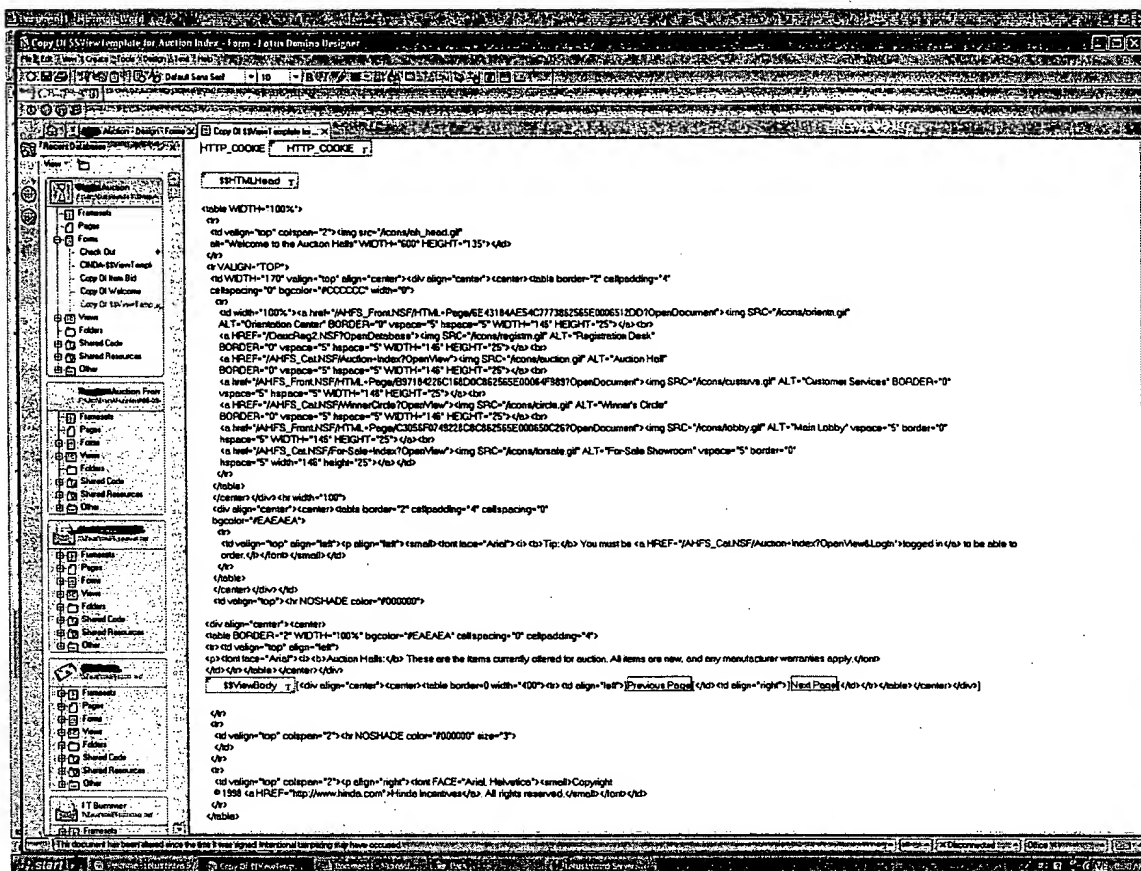
Item Details

Item: 215
Description: Web Item Bidding
Start Date/Time: 01/12/2000 05:10:54 PM
End Date/Time: 01/12/2000 05:10:54 PM
Accepted Bids: Cris Jennings/HQDA

Item Details

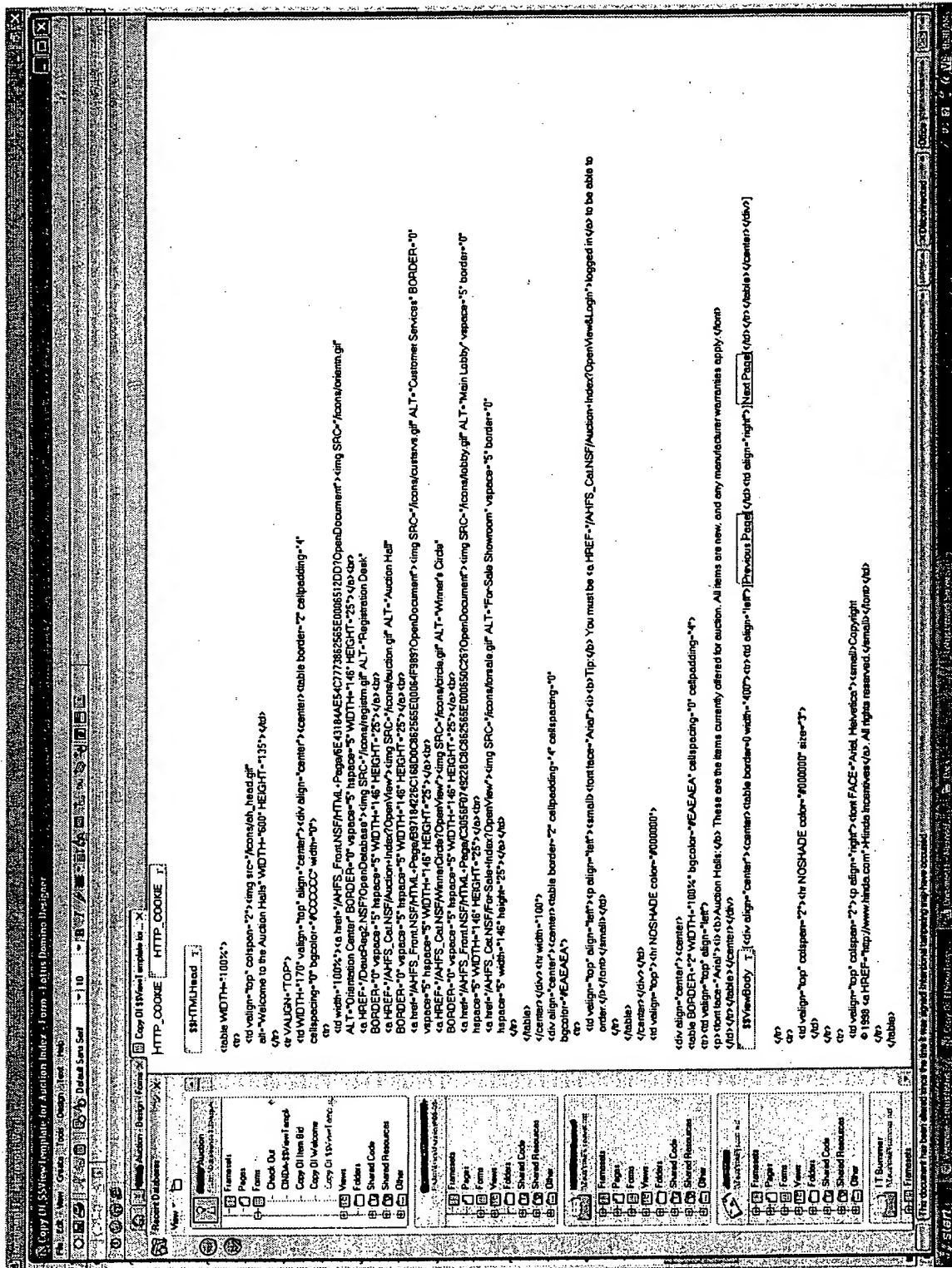
Item: 216
Description: Web Item Bidding
Start Date/Time: 01/12/2000 05:10:54 PM
End Date/Time: 01/12/2000 05:10:54 PM
Accepted Bids: Cris Jennings/HQDA

Copy of Item Bid Form



	Name / Comment	Align C	Last Modified C	Last Modified By C	Mrs. Ralston	History	Web	Mobile
Check Out			06/07/1999 11:25:18 AM	Michael O'Connor/Chairman				
CMDA \$5/evnt enable for Auction Indr			01/12/2000 05:05:00 PM	Crisle Jennings/MIDA				
Copy Of Item Bld			06/08/1999 06:13:24 PM	Jane Replogle/Chairman				
Copy Of Webcam			07/14/1999 10:25:50 AM	Brian Mucha/MIDA				
Copy Of EVent enable for Auction Indr			06/29/1999 04:59:59 PM	Jane Replogle/Chairman				
Copy Of EVent enable for VmwareCard			01/12/2000 05:10:54 PM	Crisle Jennings/MIDA				
For Sale Item			06/07/1999 11:25:15 AM	Michael O'Connor/Chairman				
Item			06/07/1999 11:25:18 AM	Michael O'Connor/Chairman				
Item Bld			07/16/1999 11:04:10 AM	Brian Mucha/MIDA				
Shopping Cart			06/07/1999 11:25:16 AM	Michael O'Connor/Chairman				
Webcam			07/16/1999 11:00:59 AM	Brian Mucha/MIDA				
\$5/evnt enable for Auction Indr			01/13/2000 08:00:51 AM	Crisle Jennings/MIDA				
\$5/evnt enable for For Sale Indr			07/16/1999 03:11:10 PM	Brian Mucha/MIDA				
\$5/evnt enable for VmwareCard			01/13/2000 08:01:53 AM	Crisle Jennings/MIDA				
(Web For Sale Item)		For Sale Item	06/07/1999 11:25:15 AM	Michael O'Connor/Chairman				
(Web Item Bld-dsp)			06/07/1999 11:25:16 AM	Michael O'Connor/Chairman				
(Web Item Bld)		Item Bld	01/12/2000 05:10:31 PM	Crisle Jennings/MIDA				
(Web Item)		Item	01/12/2000 05:10:37 PM	Crisle Jennings/MIDA				

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Size:	12,878 bytes



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Check Out		Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM	Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM
CHDA \$5/week for Auction Ind		Cris Jernigan/HNDAA	07/12/2000	05:05:03 PM	Cris Jernigan/HNDAA	07/12/2000	05:05:03 PM
Copy Of Item Bid		Jeanne Hoping/O'Neil/HNDAA	06/09/1999	06:12:24 PM	Jeanne Hoping/O'Neil/HNDAA	06/09/1999	06:12:24 PM
Copy Of Welcome		Brian Muehle/HNDAA	07/14/1999	10:25:50 AM	Brian Muehle/HNDAA	07/14/1999	10:25:50 AM
Copy Of \$5/week for Auction Ind		Jeanne Hoping/O'Neil/HNDAA	06/09/1999	06:05:38 PM	Jeanne Hoping/O'Neil/HNDAA	06/09/1999	06:05:38 PM
Copy Of \$5/week for Welcome Card		Cris Jernigan/HNDAA	07/12/2000	05:10:54 PM	Cris Jernigan/HNDAA	07/12/2000	05:10:54 PM
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Item Bid		Brian Muehle/HNDAA	07/15/1999	11:04:10 AM	Brian Muehle/HNDAA	07/15/1999	11:04:10 AM
Shipping Card		Michael O'Connor/HNDAA	06/07/1999	11:25:16 AM	Michael O'Connor/HNDAA	06/07/1999	11:25:16 AM
Welcome		Brian Muehle/HNDAA	07/15/1999	11:05:59 AM	Brian Muehle/HNDAA	07/15/1999	11:05:59 AM
\$5/week for Auction Ind		Cris Jernigan/HNDAA	07/13/2000	08:00:51 AM	Cris Jernigan/HNDAA	07/13/2000	08:00:51 AM
\$5/week for For Sale Ind		Brian Muehle/HNDAA	07/15/1999	03:11:01 PM	Brian Muehle/HNDAA	07/15/1999	03:11:01 PM
\$5/week for Welcome Card		Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM	Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM
For Sale Item		Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM	Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM
Web Item Bid		Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM	Michael O'Connor/HNDAA	06/07/1999	11:23:18 AM
Web Item Bid		Cris Jernigan/HNDAA	07/12/2000	05:10:54 PM	Cris Jernigan/HNDAA	07/12/2000	05:10:54 PM
Web Item		Cris Jernigan/HNDAA	07/12/2000	05:18:27 PM	Cris Jernigan/HNDAA	07/12/2000	05:18:27 PM

Auction Items Form

[illegible]

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[illegible]

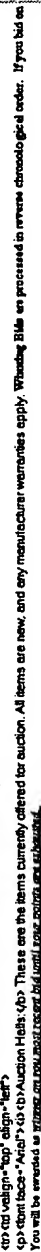
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1	Check Out	Check Out	Form	Active	06/07/1999	11:26:18 AM	Michael O'Connor/Chitram	Web	Mobile															
2	CHDA-S\$View1 template for Auction Index	CHDA-S\$View1 template for Auction Index	Form	Active	01/12/2000	05:05:00 PM	Crde Jennings/HIDA																	
3	Copy 01 Item Bid	Copy 01 Item Bid	Form	Active	06/09/1999	06:13:24 PM	Jane Rasing/Chitram																	
4	Copy 01 Welcome	Copy 01 Welcome	Form	Active	07/14/1999	10:25:50 AM	Brian Mucha/HIDA																	
5	Copy 01 \$5View1 template for Auction Index	Copy 01 \$5View1 template for Auction Index	Form	Active	06/09/1999	01:05:38 PM	Jane Rasing/Chitram																	
6	Copy 01 Welcome	Copy 01 Welcome	Form	Active	01/12/2000	05:10:54 PM	Crde Jennings/HIDA																	
7	For Sale Item	For Sale Item	Form	Active	06/07/1999	11:25:15 AM	Michael O'Connor/Chitram																	
8	Item	Item	Form	Active	06/07/1999	11:25:18 AM	Michael O'Connor/Chitram																	
9	Item Bid	Item Bid	Form	Active	07/15/1999	11:04:10 AM	Brian Mucha/HIDA																	
10	Welcome	Welcome	Form	Active	07/15/1999	11:30:59 AM	Brian Mucha/HIDA																	
11	\$5View1 template for Auction Index	\$5View1 template for Auction Index	Form	Active	01/12/2000	08:03:51 AM	Crde Jennings/HIDA																	
12	\$5View1 template for For Sale Index	\$5View1 template for For Sale Index	Form	Active	07/15/1999	03:11:10 PM	Brian Mucha/HIDA																	
13	\$5View1 template for Welcome	\$5View1 template for Welcome	Form	Active	01/12/2000	08:01:53 AM	Crde Jennings/HIDA																	
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15	Web Item Bid	Web Item Bid	Form	Active	06/07/1999	11:25:16 AM	Michael O'Connor/Chitram																	
16	Web Item Bid	Web Item Bid	Form	Active	01/12/2000	05:16:31 PM	Crde Jennings/HIDA																	
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ShoppingCart Form

Name/Comments	Check Out	Lot Modified By	Lot Modified On	No. Bids	Buyer	Web	Mobile
Check Out		Michael O'Connor/Chatham	06/07/1999 11:25:10 AM				
CHDA-\$5/entl emplate for Auction Ind		Cinda Jennings/HINDA	07/12/2000 05:05:03 PM				
Copy 01 Item Bid		Jamie Rapping/Chatham	06/08/1999 08:13:24 PM				
Copy 01 Welcome		Brian Mucha/HINDA	07/14/1999 10:25:50 AM				
Copy 01 \$5/entl emplate for Auction Ind		Jamie Rapping/Chatham	06/08/1999 01:05:38 PM				
Copy 01 \$5/entl emplate for WinnetCard		Cinda Jennings/HINDA	07/12/2000 05:10:54 PM				
For Sale Item		Michael O'Connor/Chatham	06/07/1999 11:25:15 AM				
Item		Michael O'Connor/Chatham	06/07/1999 11:25:19 AM				
Item Bid		Brian Mucha/HINDA	07/15/1999 11:04:10 AM				
Shipping Cart		Michael O'Connor/Chatham	06/07/1999 11:25:16 AM				
Item Bid		Cinda Jennings/HINDA	07/12/2000 05:05:03 AM				
\$5/entl emplate for Auction Ind		Cinda Jennings/HINDA	07/15/1999 03:11:10 PM				
\$5/entl emplate for For Sale Ind		Cinda Jennings/HINDA	07/12/2000 05:01:53 AM				
\$5/entl emplate for WinnetCard		Michael O'Connor/Chatham	06/07/1999 11:25:15 AM				
For Sale Item		Michael O'Connor/Chatham	06/07/1999 11:25:16 AM				
Item Bid		Cinda Jennings/HINDA	07/12/2000 05:18:37 PM				
Item		Cinda Jennings/HINDA	07/12/2000 05:18:37 PM				

(A) (B) (C) (D) (E) (F) (G) (H) (I) (J) (K) (L) (M) (N) (O) (P) (Q) (R) (S) (T) (U) (V) (W) (X) (Y) (Z)

\$\$\$View Template For Auction Index



[illegible]



Sharp Auction - Auction Items - Lotus Notes

File Edit View Create Actions Help



Auction
 Administration
 Auction Items
 For-Sale Items

Welcome
 Inbox
 Auction - Auction Items

Create Item
 Edit Item

Items	Description	Inv	Available	Bid	Increment	Shipping	MSRP	Cost	SKU
Auction 8									
20199-8	Sharp® 27" Stereo TV	1	1	\$199	\$15	\$20			27LS100
20198-8	Lorus® Mickey Mouse® Chronograph	1	1	\$20	\$5	\$5			WY047
20197-8	HealthRider® with Weight Bar	1	1	\$99	\$10	\$20			HEALTHRIDE
20196-8	Bausch & Lomb® Iso Sunglasses	1	1	\$5	\$2	\$5			WY556-309A
20195-8	X-Sports® TriTex Stand Bag with Dual Strap	1	1	\$29	\$5	\$9			12301
20193-8	DeWalt® 14.4 Volt Cordless Saw Kit	1	1	\$199	\$10	\$14			DW935K
20192-8	Diamond Tennis Bracelet	1	1	\$299	\$25	\$12			BR871-1
20191-8	All-Clad® 9 Piece LTD Cookware Set	1	1	\$299	\$25	\$17			3099-9NS
20190-8	Coach® Ladies Burgundy Compact Clutch	1	1	\$39	\$5	\$5	\$135		4882BRG
20189-8	American Harvest® Breadmaker	1	1	\$89	\$5	\$12	\$280		BC2000
20188-8	Nikon® Nice-Touch Zoom Camera with Bull	1	1	\$99	\$10	\$5	\$182		1853
20187-8	JB Research® Portable Massager	1	1	\$29	\$3	\$5	\$100		CCS908
20186-8	Selko® Pendulum Mantel Clock	1	1	\$39	\$3	\$5	\$130		QPW1406
20185-8	Tiffany® Handel-Inspired Lamp, A Collector's	1	1	\$49	\$5	\$9	\$250		10063-611
20184-8	Kosta Bodal® Fanfare Candlesticks	1	1	\$29	\$5	\$5	\$120		68205(2)
20183-8	Wedgewood® Johnson Brothers® Dinnerw	1	1	\$39	\$5	\$14	\$360		2499493
20182-8	London Fog® Travel Tote (Sage)	1	1	\$10	\$2	\$5	\$55		1306SG
20181-8	London Fog® Carry-On (Black)	1	1	\$20	\$3	\$5	\$110		1302BK
20180-8	London Fog® Carry-On (Sage)	1	1	\$20	\$3	\$5	\$110		1302SG
20179-8	Bally® Leather Change Purse	1	1	\$49	\$5	\$5	\$140		50250
20178-8	Shop Vac® Wet/Dry Vacuum	1	1	\$25	\$5	\$9	\$120		333-34-004
20176-8	Hikma® Porsche® 911 Remote Control Car	1	1	\$39	\$5	\$5	\$100		14035
20175-8	Vise-Grip® Three-Piece Pliers Kit	1	1	\$16	\$3	\$5	\$45	\$22	321P
20174-8	Sharp® 3" Color LCD Touchscreen Viewcar	1	1	\$475	\$15	\$5	\$453		YH375U
20173-8	London Fog® Over-Nighter (Sage)	1	1	\$25	\$5	\$5	\$140		131BSG
20172-8	Swiss Army® Calvary Watch for Ladies	1	1	\$9	\$5	\$5	\$175		2424B
20171-8	Kelly® Backpack - Olive	1	1	\$12	\$2	\$5	\$40		WYNDHAM-C
20170-8	Kelly® Backpack - Black	1	1	\$12	\$2	\$5	\$40		WYNDHAM-T
Auction 7									
Auction 6									

\$\$ View Template For Winner Circle



[illegible]

[illegible]

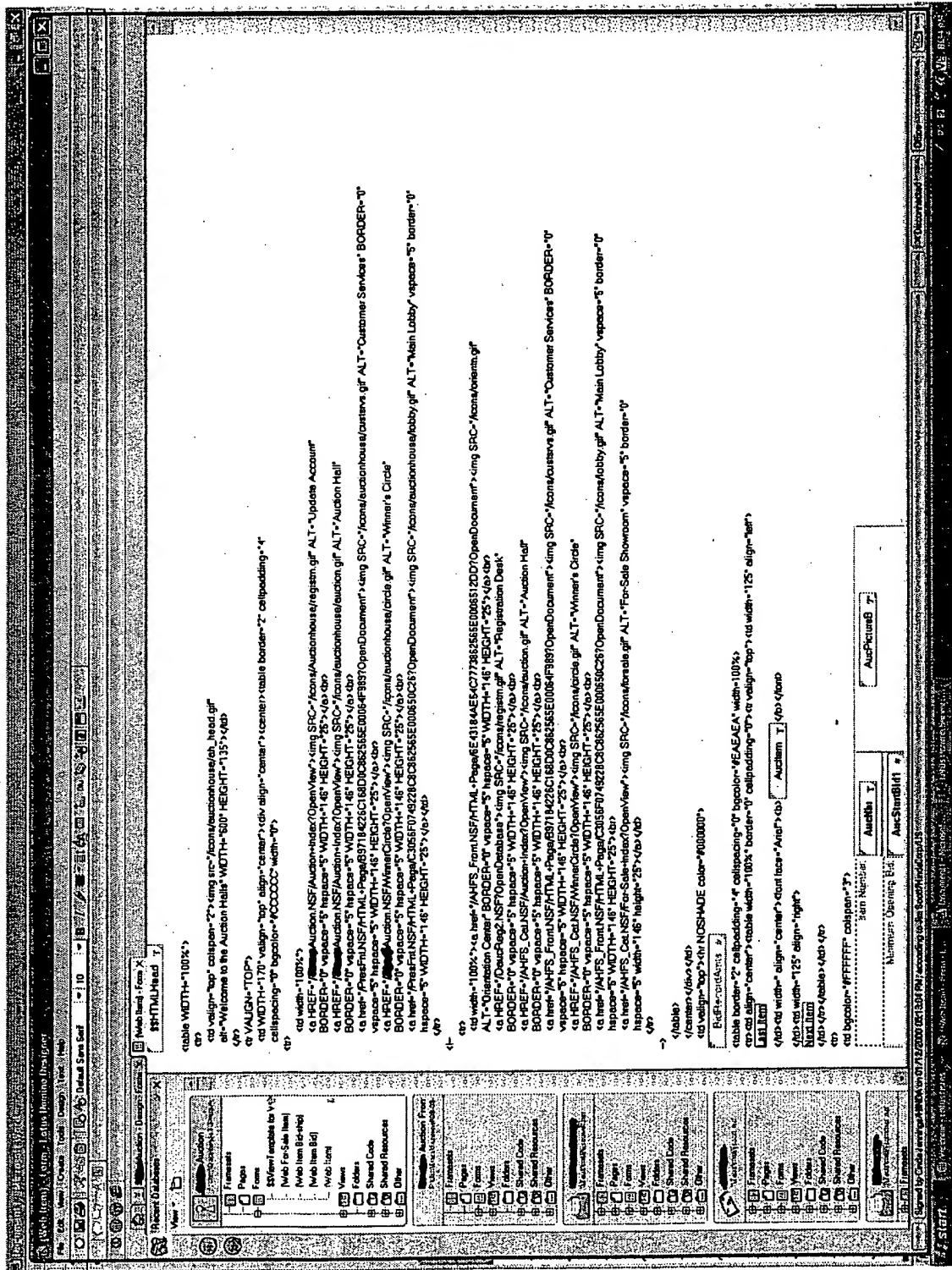
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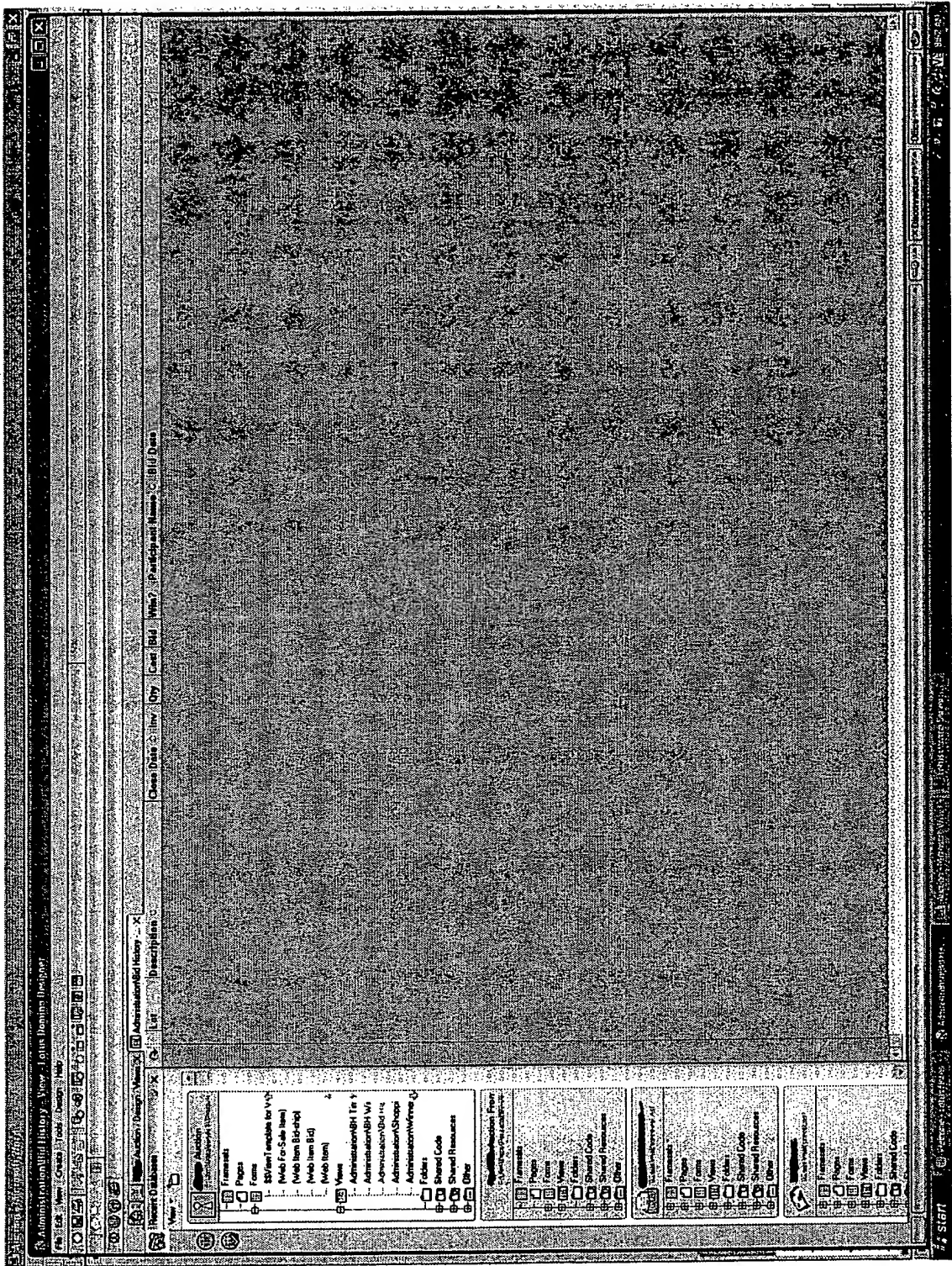
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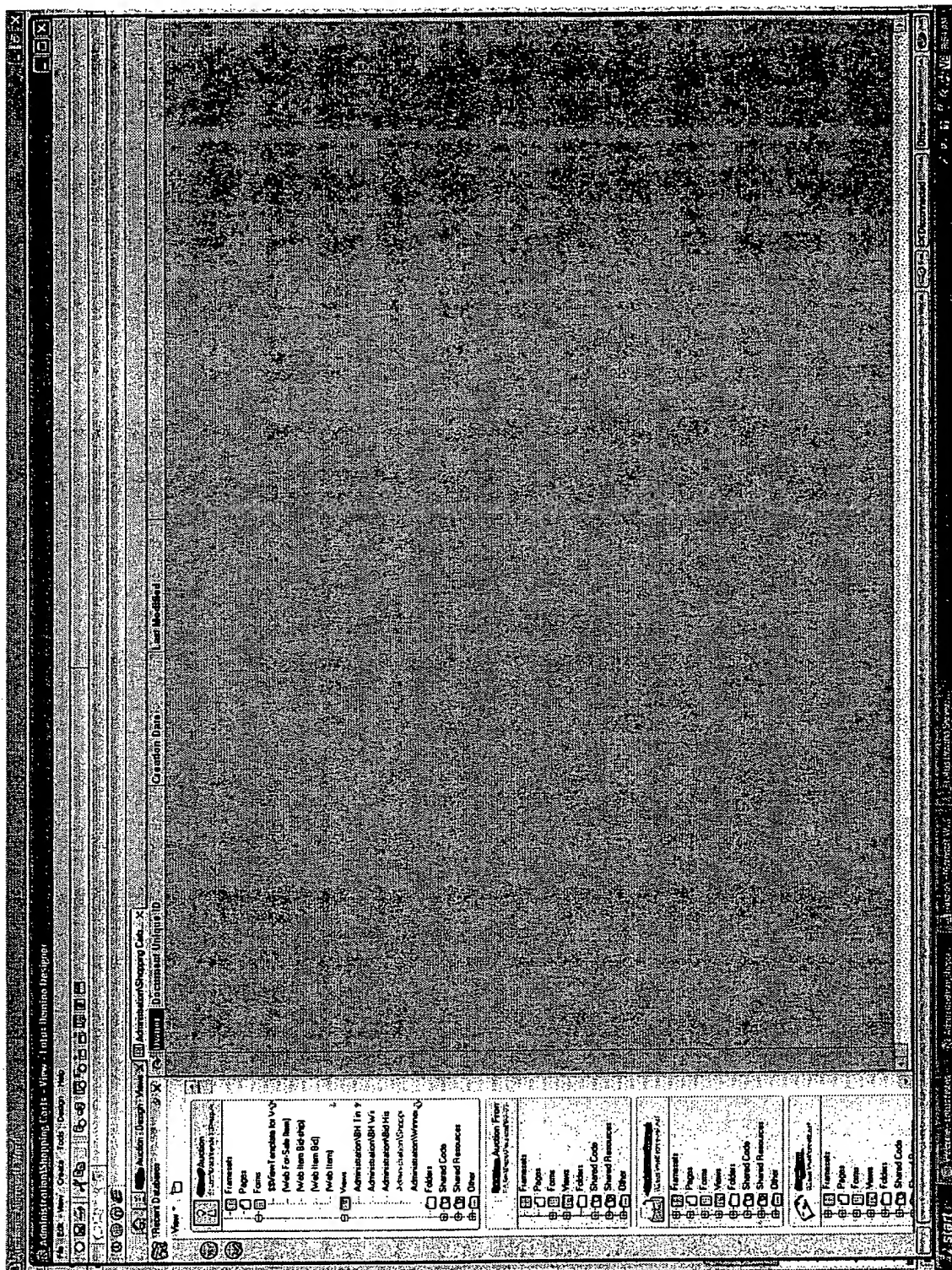




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Modified: 06/10/1999 03:13:47 PM (In this file)

Modified by: Michael O'Connor/Chi Information Engineering

Accessed: 06/10/1999 (In this file)

Size: 13,726 (bytes)

Shopping Cart - Form - Lotus Domino Designer

Recent Databases:

- Auction House Front
- Auction House Back
- Auction House Admin
- Auction House Reports
- Auction House Search
- Auction House Shipping
- Auction House Tracking
- Auction House Warehouse
- Auction House Warehouse Admin
- Auction House Warehouse Reports
- Auction House Warehouse Search
- Auction House Warehouse Shipping
- Auction House Warehouse Tracking
- Auction House Warehouse Warehouse

Auction House For Sale Shopping Cart

Item	Description	Qty	Price	Shipping	Totals
CartNbr	CartItem	CartQty	CartPrice	AuchHndChgr	Totals
				Sub Total	SubTotal
				Handling	Handling
				Total Due	TotalDue

For Item Change Quantity to

Remove Item Number

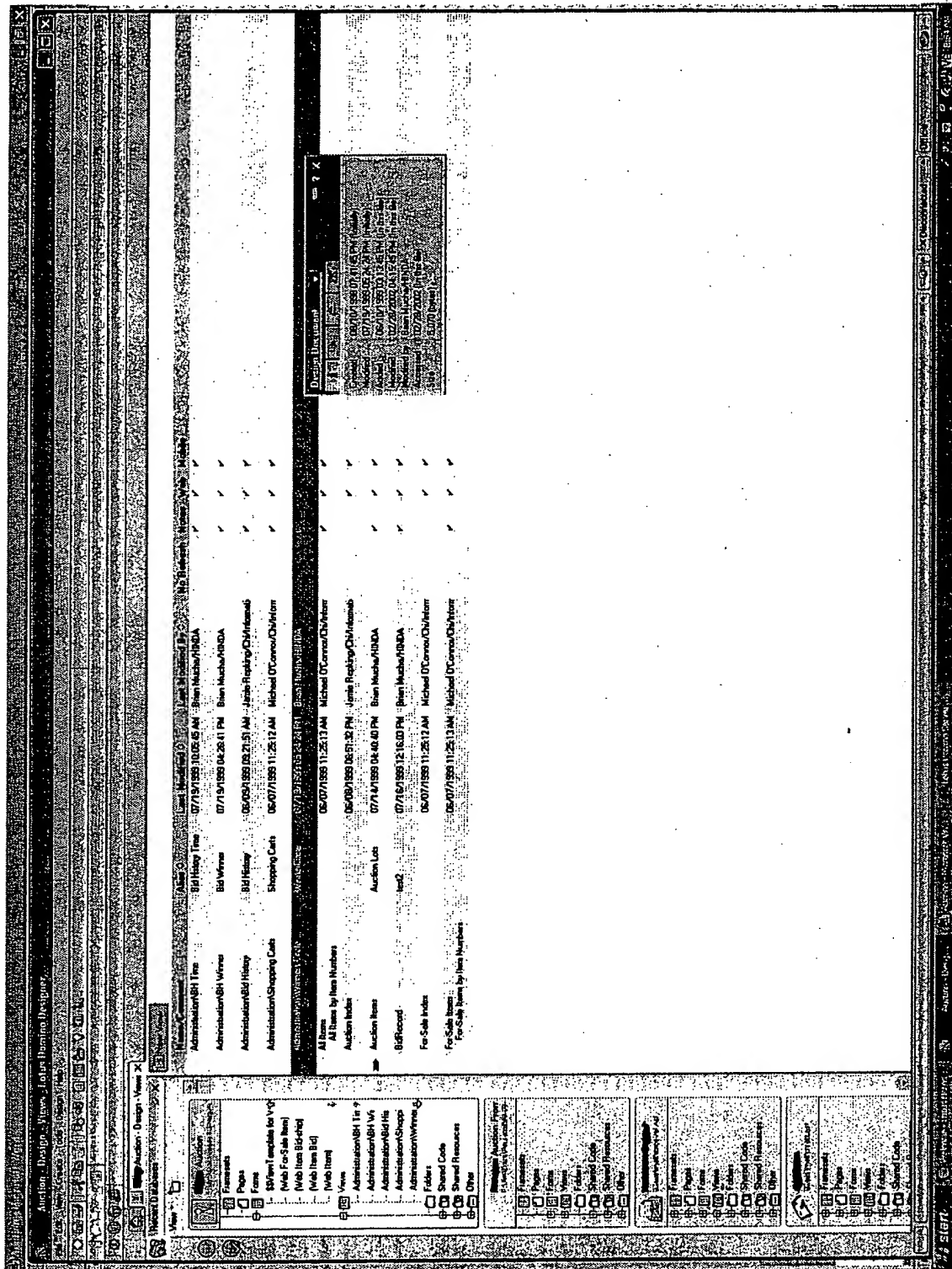
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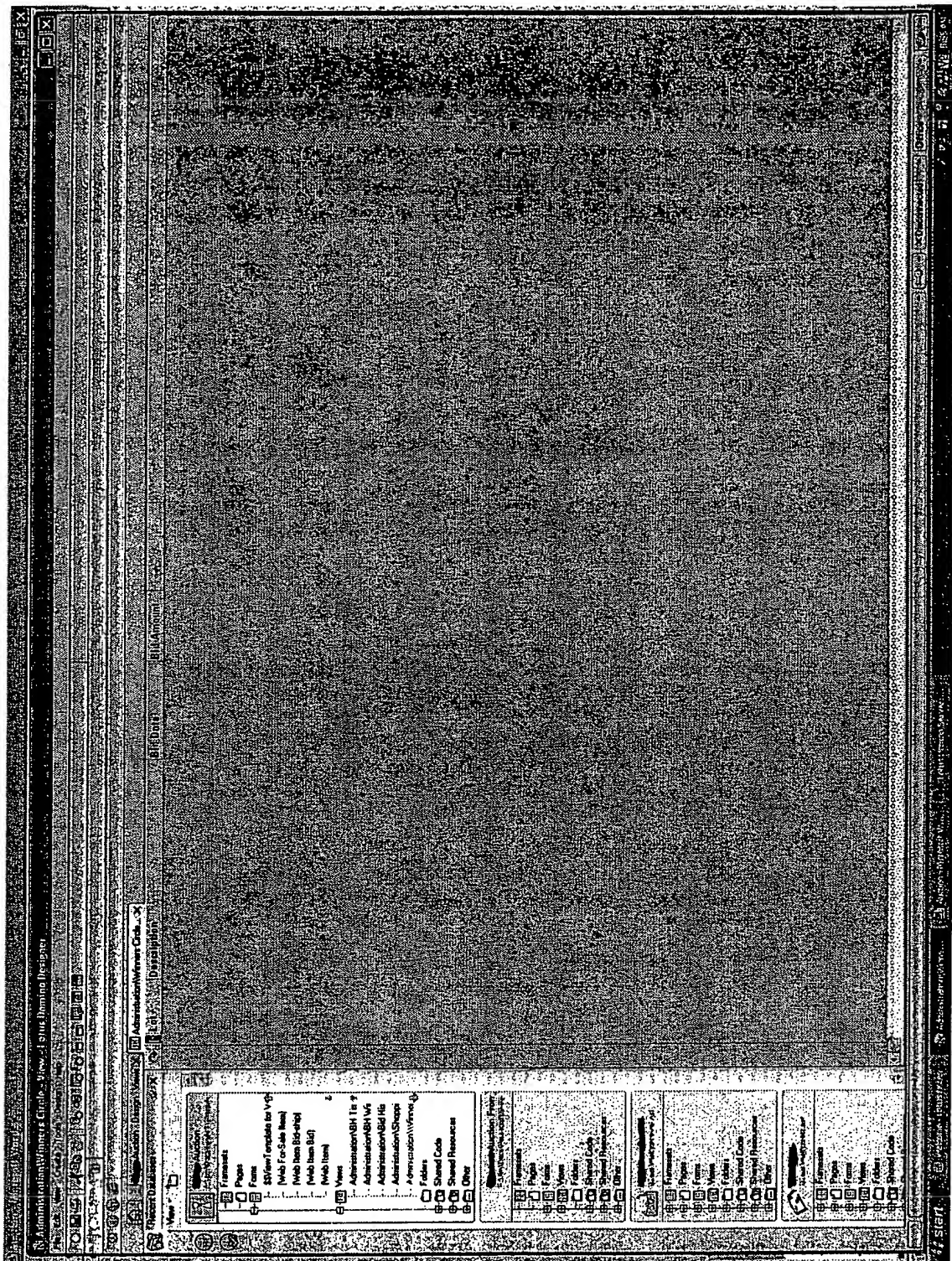
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Buttons:

Footer: Auction House Front d:\Auction\HNSF



Administration / Winners Circle View



Design Document [icon] ? X

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 Modified: 07/19/1999 05:24:27 PM [in this file]
 Added: 06/10/1999 03:13:45 PM [in this file]
 Modified: 02/19/2002 02:26:27 PM [in this file]
 Modified by: Brian Mueha/HINDA
 Accessed: 02/19/2002 [in this file]
 Size: 6,015 (bytes)

Administration:Winners Circle - View - Lotus Domino Designer

Administration:Winners Circle - View

Lot	Description	Lot Date	Lot Amount
20199	Sharp 27" Stereo TV	07/18/1999 07:12 PM	87000
20198	Lotus 6" Mickey Mouse Chronograph	07/18/1999 06:55 PM	6500
200196	Bausch & Lomb 1 1/2" Sunglasses	07/19/1999 03:55 PM	4200
20195	2 1/2" Sports Tiller Stand Bar with Dual Strap	07/19/1999 03:11 PM	5000
20193	DeWalt 14 1/4" Volt Cordless Saw Kit	07/19/1999 04:00 PM	39000
20192	Diamond Tennis Bracelet	07/19/1999 03:53 PM	84000
20191	All-Clad 3 Piece LTD Cookware Set	07/19/1999 02:48 PM	69000
20189	American Harvest Breadmaker	07/19/1999 01:04 PM	18000
20188	Nikon Nice Touch Zoom Camera with Bulb	07/19/1999 03:25 PM	23000
20187	JB Research Portable Message Pad	07/19/1999 03:56 PM	7000
20186	Seiko Pendulum Mantel Clock	07/19/1999 12:49 PM	9500
20185	Tiffany Hard Rock Inspired Gem-Art Collector	07/19/1999 01:51 PM	2800
20184	Kosta Boro Fantasy Candles (Set)	07/17/1999 06:28 AM	55000
20183	Wedgewood Johnson Brothers Dinnerware	07/19/1999 01:43 PM	18000
20182	London Fog® Travel Tote (Sage)	07/19/1999 07:49 AM	2400
20181	London Fog® Carry-On Backpack	07/19/1999 07:49 AM	2400
20180	London Fog® Carry-On Bagel	07/19/1999 06:39 AM	2400
20179	Sharp Vapo Max One Vacuum	07/19/1999 07:11 PM	9700
20178	Nikko Porsche® 911 Remote Control Car	07/19/1999 01:46 PM	15000
20177	Vico® Green Glass Place Pillars (Set)	07/19/1999 01:19 PM	1600
20176	Sharp 35" Color LCD Touchscreen Viewcam	07/19/1999 11:52 AM	16000
20175	London Fog® Over Nighter (Sage)	07/19/1999 08:57 AM	2000
20174	Swiss Army® Calvary Watch for Ladies	07/19/1999 12:46 PM	5500
20173	Kelby Backpack (Olive)	07/19/1999 01:03 PM	3500
20172	Kelby Backpack (Black)	07/19/1999 01:04 PM	3500

Resources: Images, Applets, Subforms, Shared Fields, Script Libraries, Other

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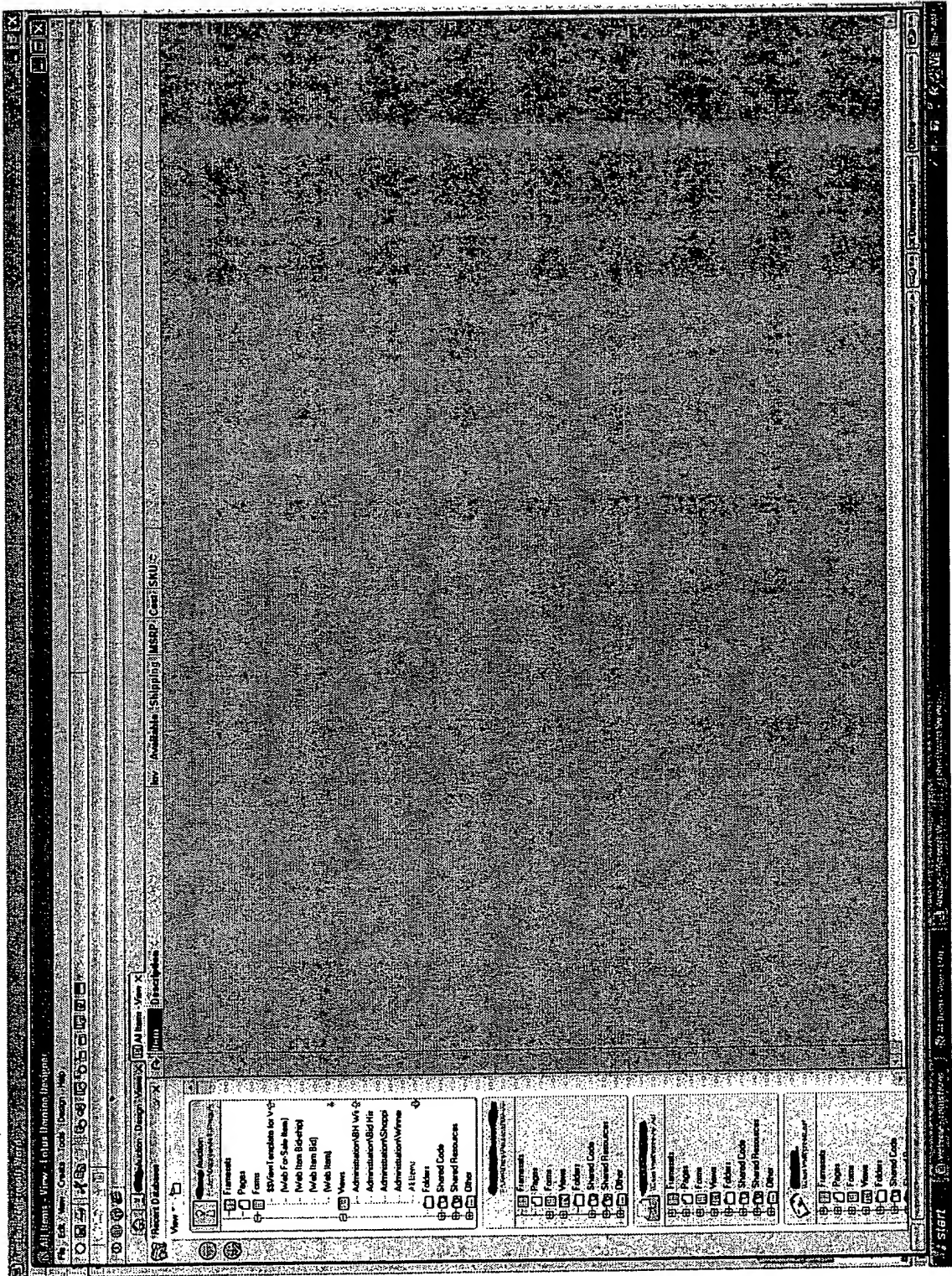
Outline, Framesets, Pages, Forms, Views, Folders, Navigators, Agents, Synopses, Resources

Hinder Corporation, Inc. hinda.c

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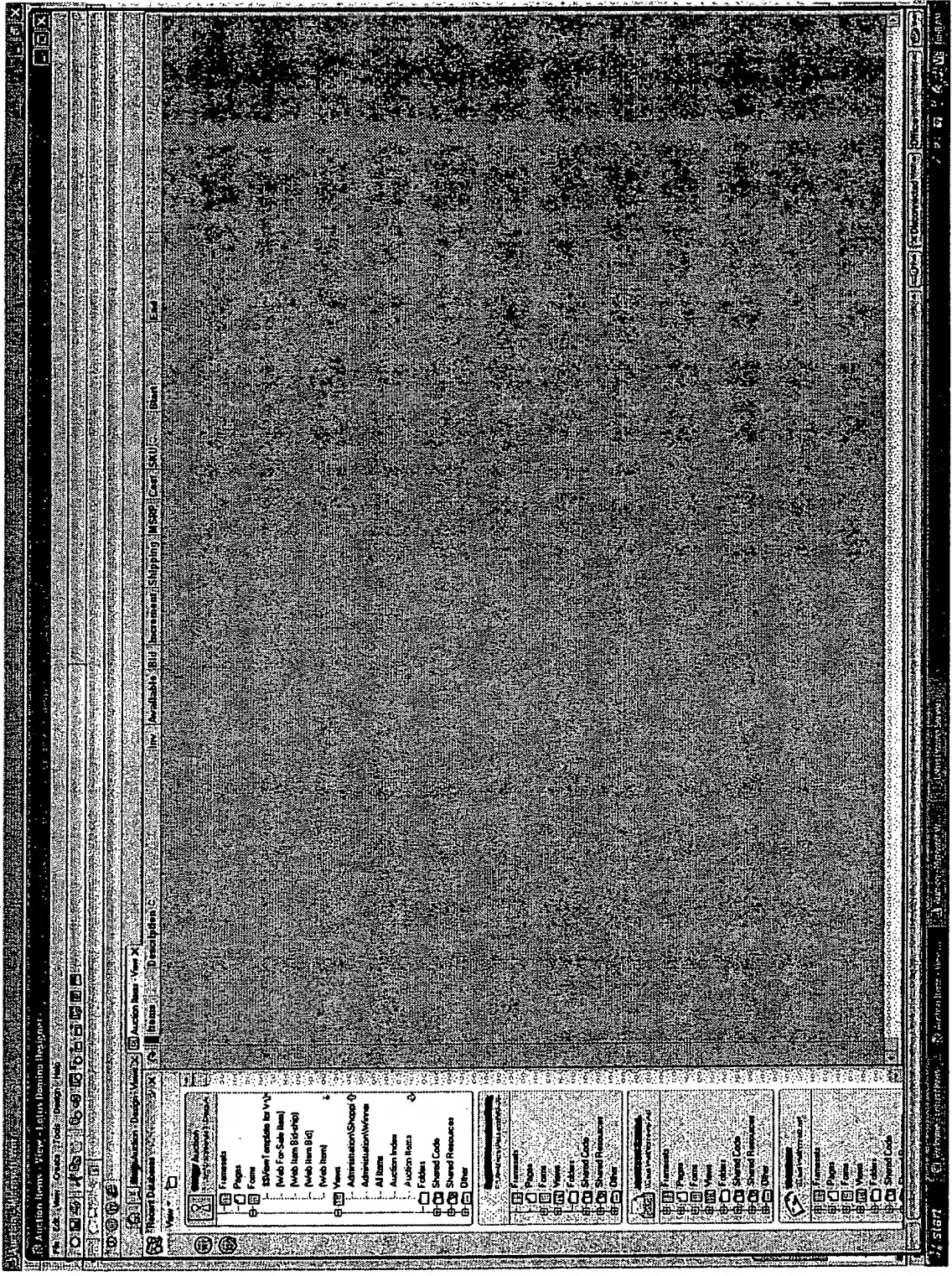
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All Items View



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[illegible]



[illegible]

Auction Item Index

File Edit View Options Tools Design Help

Recent Databases: Auction - Design - Views - Lotus Item Index Design

View: ☒ All ☐ Pages ☐ Forms ☐ Views ☐ Shared Code ☐ Shared Resources ☐ Other

Name/Comment	Admin C	Last Modified	Last Modified By	No Refresh	Home	Web	Mobile
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Administration/Winners Circle	Winners Circle	07/19/1999 05:24:48 PM	Ben Machu/HIDA				
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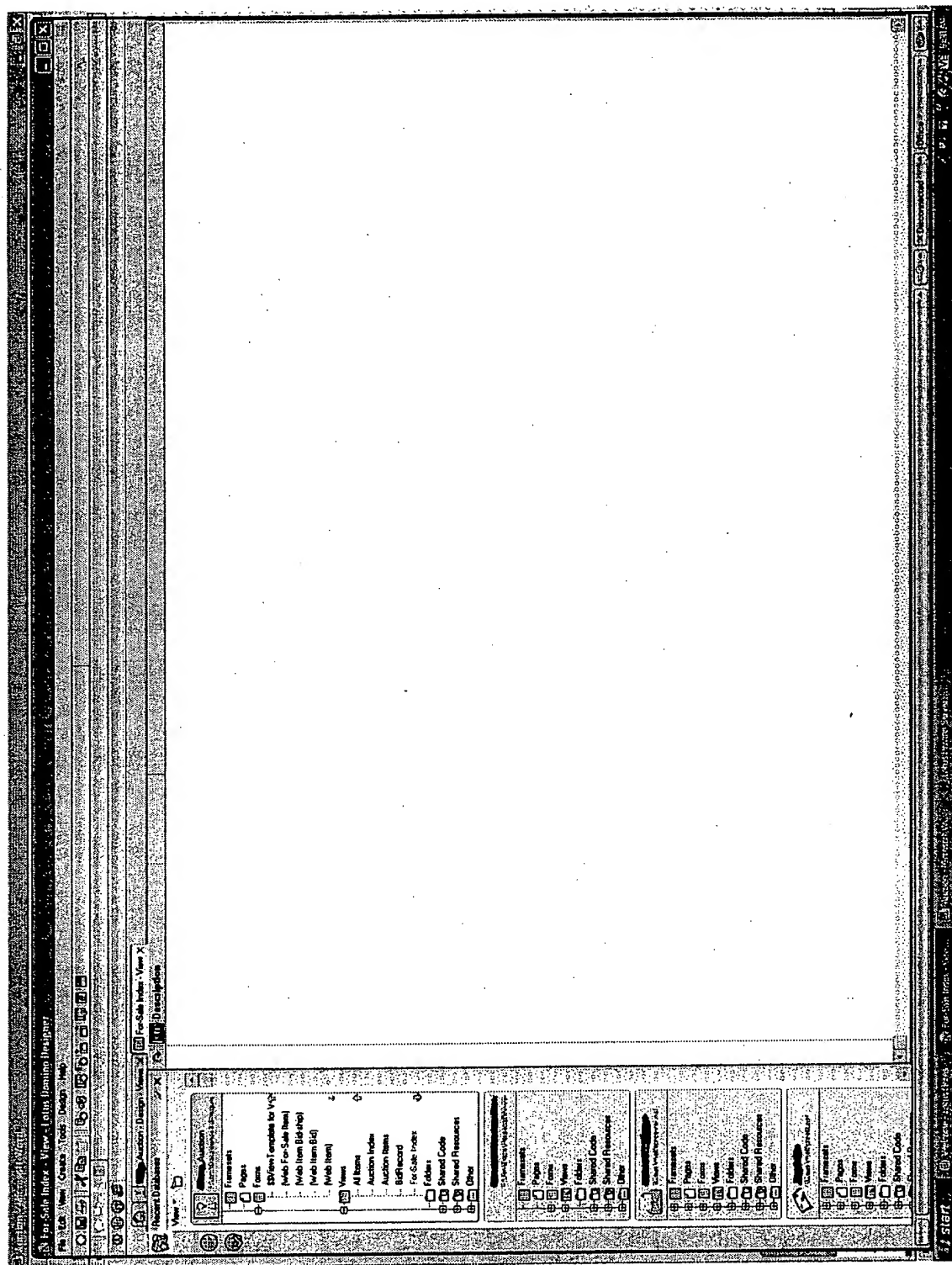
For Sale Items
For Sale Items by Item Numbers

06/07/1999 11:25:13 AM Michael O'Connor/CH/HIDA

Design Document

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Modified: 06/07/1999 11:25:12 AM (Friday)
Author: 06/07/1999 03:45:45 PM (Friday)
Modified: 06/07/1999 07:03:02 AM (Friday)
Reviewed by: Michael O'Connor/CH/HIDA
Reviewed: 06/10/1999 11:25:13 AM
Size: 1,227 Bytes

Auction Item Index





action the applicant should be informed of this alteration in the amendment and the entry of the amendment as thus amended. The applicant will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

714.24 Amendment of Amendments [R-2]

When a replacement paragraph or section *of< the specification is to be amended, it should be wholly rewritten and the original insertion canceled**. >A marked-up version of the replacement paragraph or section of the specification should be presented using underlining to indicate added subject matter and strike-through to indicate deleted subject matter.< Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion. A claim cancelled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

714.25 Discourtesy of Applicant or Attorney [R-2]

**>

37 CFR 1.3. Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.<

All papers received in the U.S. Patent and Trademark Office should be briefly reviewed by the technical support staff, before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney or agent is discourteous in the remarks or arguments in his or her amendment, either the discourtesy should be entirely ignored or the paper submitted to the Technology Center (TC) Director **>for review<. See MPEP § 1003. If the TC Director determines that the remarks are in violation of

37 CFR 1.3, the TC Director will **>send a notice of non-entry of the paper to the applicant<.

715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131 [R-2]

37 CFR 1.131. Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n); or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

37 CFR 1.131(a) has been amended to implement the relevant provisions of Public Law 103-182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Act), Public Law 103-465, 108 Stat. 4809 (1994) (Uruguay Round Agreements Act), and Public Law 106-113, 113 Stat. 1501 (1999) (American Inventors Protection Act), respectively. Under 37 CFR 1.131(a) as amended, which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of comple-

tion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act (URAA). Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

If a country joined the WTO after January 1, 1996, the effective date for proving inventive activity in that country for the purpose of 35 U.S.C. 104 and 37 CFR 1.131 is the date the country becomes a member of the WTO. See MPEP § 201.13 for a list that includes WTO member countries (the notation “W⁰” indicates the country became a WTO member after January 1, 1996).

Any printed publication or activity dated prior to an applicant's or patent owner's effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application or patent under reexamination. In addition, patent application publications and certain international application publications having an effective prior art date prior to the application being examined may be used in a rejection of the claims. See MPEP § 706.02(a) and § 2136 - § 2136.03.

Such a rejection may be overcome, in certain instances noted below, by filing of an affidavit or declaration under 37 CFR 1.131, known as “swearing back” of the reference.

It should be kept in mind that it is the rejection that is withdrawn and not the reference.

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I. < SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED

Affidavits or declarations under 37 CFR 1.131 may be used, for example:

(A) To antedate a reference or activity that qualifies as prior art under 35 U.S.C. 102(a) and not under 35 U.S.C. 102(b), e.g., where the prior art date under

35 U.S.C. 102(a) of the patent, the publication or activity used to reject the claim(s) is less than 1 year prior to applicant's or patent owner's effective filing date.

(B) To antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention. See MPEP § 715.05 for a discussion of “same patentable invention.” See MPEP § 706.02(a) and § 2136 through § 2136.03 for an explanation of what references qualify as prior art under 35 U.S.C. 102(e).

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II. < SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE

An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations:

(A) Where the reference publication date is more than 1 year prior to applicant's or patent owner's effective filing date. Such a reference is a “statutory bar” under 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2). A reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a “statutory bar.”

(B) Where the reference U.S. patent or U.S. patent application publication claims the same patentable invention. See MPEP § 715.05 for a discussion of “same patentable invention” and MPEP § 2306. Where the reference patent and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

(C) Where the reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than 12 months prior to the filing date of the domestic application. See 35 U.S.C. 102(d).

(D) Where the effective filing date of applicant's or patent owner's parent application or an International Convention proved filing date is prior to the effective date of the reference, an affidavit or declaration under 37 CFR 1.131 is unnecessary because the reference **should not have been used*. See MPEP § 201.11 to § 201.15.

(E) Where the reference is a prior U.S. patent to the same entity, claiming the same invention. The question involved is one of "double patenting."

(F) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending. The question is one of dedication to the public. Note however, *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971) which substantially did away with the doctrine of dedication.

(G) Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964).

(H) Where the subject matter relied upon is prior art under 35 U.S.C. 102(f).

(I) Where the subject matter relied on in the reference is prior art under 35 U.S.C. 102(g). 37 CFR 1.131 is designed to permit an applicant to overcome rejections based on references or activities which are not statutory bars, but which have dates prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 CFR 1.131 affidavit or declaration cannot be used to overcome it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his or her invention. By contrast, references under 35 U.S.C. 102(a) and (e), for example, merely establish a presumption that their subject matter was made before applicant's invention date. It is this presumption which may be rebutted by evidence submitted under 37 CFR 1.131.

(J) Where the subject matter corresponding to a lost count in an interference is either prior art under 35 U.S.C. 102(g) or barred to applicant by the doctrine of interference estoppel. *In re Bandel*, 348 F.2d 563, 146 USPQ 389 (CCPA 1965); *In re Kroekel*, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986). See also *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (Under the principles of *res judicata* and *collateral estoppel*, applicant was not entitled to claims that were patentably indistinguishable from the claim lost in interference even though the subject matter of the lost count was not available for use in an obviousness rejection under 35 U.S.C. 103). But see *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989) (A losing party to an interference, on showing that the invention now claimed is not "substantially the same" as that of the lost count, may employ the procedures of 37 CFR 1.131 to antedate the filing date of an interfering application). On the matter of when a "lost count" in an interference constitutes prior art under 35 U.S.C. 102(g), see *In re McKellin*, 529 F.2d 1342, 188 USPQ 428 (CCPA 1976) (A count is not prior art under 35 U.S.C. 102(g) as to the loser of an interference where the count was lost based on the winner's foreign priority date). Similarly, where one party in an interference wins a count by establishing a date of invention in a NAFTA or WTO member country (see 35 U.S.C. 104), the subject matter of that count is unpatentable to the other party by the doctrine of interference estoppel, even though it is not available as statutory prior art under 35 U.S.C. 102(g). See MPEP § 2138.01 and § 2138.02.

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III. < REFERENCE DATE TO BE OVERCOME

The date to be overcome under 37 CFR 1.131 is the effective date of the reference (i.e., the date on which the reference is available as prior art).

A. U.S. Patents, U.S. Patent Application Publications, and International Application Publications

See MPEP § 706.02(a)>, § 706.02(f)(1),< and § 2136 through § 2136.03 for a detailed discussion of the effective date of a U.S. patent, U.S. patent applica-

tion publication, or WIPO publication of an international application as a reference.

U.S. patents, U.S. patent application publications, and WIPO publications of international applications are available as prior art under 35 U.S.C. 102(e) against all patent applications and patents under reexamination.

Should it be established that the portion of the patent, or patent application publication, disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit or declaration is the date of amendment. *In re Willien*, 74 F.2d 550, 24 USPQ 210 (CCPA 1935). The effective date of a domestic patent when used as a reference is not the foreign filing date to which the application for patent may have been entitled under 35 U.S.C. 119(a) during examination. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Therefore, the date to be overcome under 37 CFR 1.131 is the effective U.S. filing date, not the foreign priority date. When a U.S. patent or U.S. patent application publication reference is entitled to claim the benefit of an earlier filed application, its effective filing date is determined under 35 U.S.C. 102(e). See MPEP § 706.02(a)>, § 706.02(f)(1),< and § 2136 through § 2136.03.

B. Foreign Patents

See MPEP § 2126 through § 2127 regarding date of availability of foreign patents as prior art.

C. Printed Publications

A printed publication, including a published foreign patent application, is effective as of its publication date, not its date of receipt by the publisher. For additional information regarding effective dates of printed publications, see MPEP § 2128 through § 2128.02.

D. Activities

An applicant may make an admission, or submit evidence of use of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was used or known by others in this country. See MPEP § 706.02(c) and § 2133.03. The effective date of the

activity used to reject the claim(s) is the date the activity was first known to have occurred.

FORM PARAGRAPHS

Form paragraphs 7.57-7.64 may be used to respond to 37 CFR 1.131 affidavits.

¶ 7.57 Affidavit or Declaration Under 37 CFR 1.131: Ineffective- Heading

The [1] filed on [2] under 37 CFR 1.131 has been considered but is ineffective to overcome the [3] reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. This form paragraph must be followed by one or more of form paragraphs 7.58 to 7.63 or a paragraph setting forth proper basis for the insufficiency, such as failure to establish acts performed in this country, or that the scope of the declaration or affidavit is not commensurate with the scope of the claim(s).

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¶ 7.58 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Claiming Same Invention

The [1] reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Examiner Note:

1. If used to respond to the submission of an affidavit under 37 CFR 1.131, this paragraph must be preceded by paragraph 7.57.
2. This form paragraph may be used without form paragraph 7.57 when an affidavit has not yet been filed, and the examiner desires to notify applicant that the submission of an affidavit under 37 CFR 1.131 would be inappropriate.

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¶ 7.59 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction to Practice Before Reference Date

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the [1] reference. [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. An explanation of the lack of showing of the alleged reduction to practice must be provided in bracket 2.

¶ 7.60 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Reference Is a Statutory Bar

The [1] reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.57.

¶ 7.61 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the [1] reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. An explanation of the deficiency in the showing of conception must be presented in bracket 2.
3. If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this form paragraph should be followed by form paragraph 7.62 and/or 7.63. If either diligence or a reduction to practice is established, a statement to that effect should follow this paragraph.

¶ 7.62 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the [1] reference to either a constructive reduction to practice or an actual reduction to practice. [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. If the affidavit additionally fails to establish conception, this paragraph must also be preceded by form paragraph 7.61. If the affidavit establishes conception, a statement to that effect should be added to this paragraph.
3. If the affidavit additionally fails to establish an alleged reduction to practice prior to the application filing date, this paragraph must be followed by form paragraph 7.63. If such an alleged reduction to practice is established, a statement to that effect should be added to this paragraph.
4. An explanation of the reasons for a holding of non-diligence must be provided in bracket 2.
5. See MPEP § 715.07(a), *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947), which indicates that diligence is not required after reduction to practice.

¶ 7.63 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Actual Reduction to Practice

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the [1] reference. [2].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. If the alleged reduction to practice is prior to the effective date of the reference, do not use this paragraph. See form paragraph 7.59.
3. If the affidavit additionally fails to establish either conception or diligence, form paragraphs 7.61 and/or 7.62 should precede this paragraph. If either conception or diligence is established, a statement to that effect should be included after this paragraph.
4. An explanation of the lack of showing of the alleged reduction to practice must be given in bracket 2.

¶ 7.64 Affidavit or Declaration Under 37 CFR 1.131: Effective To Overcome Reference

The [1] filed on [2] under 37 CFR 1.131 is sufficient to overcome the [3] reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the name of the reference.

715.01 37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits

The purpose of a 37 CFR 1.131 affidavit or declaration is to overcome a prior art rejection by proving invention of the claimed subject matter by applicant prior to the effective date of the reference or activity relied upon in the rejection.

In some situations, an applicant may, alternatively, be able to overcome prior art rejections relying on references or activities which are available as prior art under 35 U.S.C. 102(a) or references which are available as prior art under 35 U.S.C. 102(e) by proving that the subject matter relied upon in the reference or activity was applicant's own invention.

Similarly, where the reference relied upon in a 35 U.S.C. 103 rejection qualifies as prior art only under 35 U.S.C. 102(f) or (g), or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e), applicant may be able to

overcome this rejection by proving that the subject matter relied upon and the claimed invention were commonly owned or subject to common assignment at the time the later invention was made. See MPEP § 706.02(l)(1) through § 706.02(l)(3).

715.01(a) Reference Is a Joint Patent or Published Application to Applicant and Another [R-2]

When subject matter, disclosed but not claimed in a patent or application publication filed jointly by S and another, is claimed in a later application filed by S, the joint patent or application publication is a valid reference >under 35 U.S.C. 102(a) or (e)< unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent or application publication and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent or application publication was the invention of the applicant. Disclaimer by the other patentee or applicant of the application publication should not be required but, if submitted, may be accepted by the examiner.

Although affidavits or declarations submitted for the purpose of establishing that the reference discloses applicant's invention are properly filed under 37 CFR 1.132, rather than 37 CFR 1.131, such affidavits submitted improperly under 37 CFR 1.131 will be considered as though they were filed under 37 CFR 1.132 to traverse a ground of rejection. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

715.01(b) Reference and Application Have Common Assignee

The mere fact that the reference patent or application publication which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of a showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from the applicant (MPEP § 716.10).

The common assignee does not obtain any rights in this regard by virtue of common ownership which he or she would not have in the absence of common ownership. *In re Friette*, 412 F.2d 269, 162 USPQ 163 (CCPA 1969); *Pierce v. Watson*, 275 F.2d 890, 124 USPQ 356 (D.C. Cir. 1960); *In re Beck*, 155 F.2d 398, 69 USPQ 520 (CCPA 1946). Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. See MPEP § 706.02(l) and § 706.02(l)(1).

715.01(c) Reference Is Publication of Applicant's Own Invention [R-2]

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. *Ex parte Lemieux*, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); *Ex parte Powell*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

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I. < CO-AUTHORSHIP

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a

reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

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II. < DERIVATION

When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection<, which is not a statutory bar,> on that patent or publication may be removed by submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

715.01(d) Activities Applied Against the Claims

Unless it is a statutory bar, a rejection based on an activity showing that the claimed invention was used or known prior to the filing date of the application may be overcome by an affidavit or declaration under 37 CFR 1.131 establishing a date of invention prior to the date of the activity. Alternatively, the applicant(s) may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 showing that the activity was performed by the applicant(s).

715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims [R-2]

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) (Where applicant claims an alloy comprising both nitrogen and molybdenum, an affidavit showing applicant made an alloy comprising nitrogen but not molybdenum is not sufficient under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 103 based on the combined teachings

of one reference disclosing an alloy comprising nitrogen but not molybdenum and a second reference disclosing an alloy comprising molybdenum but not nitrogen). Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. *In re Spiller*, 500 F.2d 1170,

182 USPQ 614 (CCPA 1974) (Claimed invention was use of electrostatic forces to adhere dry starch particles to a wet paper web on the Fourdrinier wire of a paper-making machine. 37 CFR 1.131 affidavit established use of electrostatic forces to adhere starch particles to wet blotting paper moved over a fluidized bed of starch particles prior to the applied reference date. Affidavit was sufficient in view of prior art reference showing that deposition of dry coatings directly on wet webs on the Fourdrinier wire of a paper-making machine was well known in the art prior to the date of the applied reference. The affidavit established possession of the basic invention, i.e., use of electrostatic forces to adhere starch to wet paper.).

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I. < SWEARING BEHIND ONE OF A PLURALITY OF COMBINED REFERENCES

Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A. However, the 37 CFR 1.131 affidavit or declaration must still establish possession of the claimed invention, not just what Reference A shows, if Reference A does not teach the basic inventive concept.

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II. < GENERAL RULE AS TO GENERIC CLAIMS

A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference or activity (assuming, of course, that the reference or activity is not a statutory bar or a patent, or an application publication, claiming the same invention). See *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964). See, also, *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968) (distinguishing chemical species of genus compounds from embodiments of a single invention). See, however, MPEP § 715.03 for practice relative to cases in unpredictable arts.

715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question [R-2]

Where generic claims have been rejected on a reference or activity which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn, subject to the rules set forth below, unless the applicant is able to establish that he or she was in possession of the generic invention prior to the effective date of the reference or activity. In other words, the affidavit or declaration under 37 CFR 1.131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

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I. < REFERENCE OR ACTIVITY DISCLOSES SPECIES

A. Species Claim

Where the claim under rejection recites a species and the reference or activity discloses the claimed species, the rejection can be overcome under 37 CFR 1.131 directly by showing prior completion of the claimed species or indirectly by a showing of prior completion of a different species coupled with a

showing that the claimed species would have been an obvious modification of the species completed by applicant. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).

B. Genus Claim

The principle is well established that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a "generic claim." *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960).

Where the only pertinent disclosure in the reference or activity is a single species of the claimed genus, the applicant can overcome the rejection directly under 37 CFR 1.131 by showing prior possession of the species disclosed in the reference or activity. On the other hand, a reference or activity which discloses several species of a claimed genus can be overcome directly under 37 CFR 1.131 only by a showing that the applicant completed, prior to the date of the reference or activity, all of the species shown in the reference. *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957).

Proof of prior completion of a species different from the species of the reference or activity will be sufficient to overcome a reference indirectly under 37 CFR 1.131 if the species shown in the reference or activity would have been obvious in view of the species shown to have been made by the applicant. *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966). Alternatively, if the applicant cannot show possession of the species of the reference or activity in this manner, the applicant may be able to antedate the reference or activity indirectly by, for example, showing prior completion of one or more species which put him or her in possession of the claimed genus prior to the reference's or activity's date. The test is whether the species completed by applicant prior to the reference date or the activity's date provided an adequate basis for inferring that the invention has generic applicability. *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA

1966); *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA 1957).

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference or activity. *In re Schaub*, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).

C. Species Versus Embodiments

References or activities which disclose one or more embodiments of a single claimed invention, as opposed to species of a claimed genus, can be overcome by filing a 37 CFR 1.131 affidavit showing prior completion of a single embodiment of the invention, whether it is the same or a different embodiment from that disclosed in the reference or activity. See *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961) (Where applicant discloses and claims a washing solution comprising a detergent and polyvinylpyrrolidone (PVP), with no criticality alleged as to the particular detergent used, the PVP being used as a soil-suspending agent to prevent the redeposition of the soil removed, the invention was viewed as the use of PVP as a soil-suspending agent in washing with a detergent. The disclosure in the reference of the use of PVP with two detergents, both of which differed from that shown in applicant's 37 CFR 1.131 affidavit, was considered a disclosure of different embodiments of a single invention, rather than species of a claimed genus); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968).

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II. < REFERENCE OR ACTIVITY DISCLOSES CLAIMED GENUS

In general, where the reference or activity discloses the claimed genus, a showing of completion of a single species within the genus is sufficient to antedate the reference or activity under 37 CFR 1.131. *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964).

In cases where predictability is in question, on the other hand, a showing of prior completion of one or a few species within the disclosed genus is generally not sufficient to overcome the reference or activity. *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA

1957). The test is whether the species completed by applicant prior to the reference date or the date of the activity provided an adequate basis for inferring that the invention has generic applicability. *In re Mantell*, 454 F.2d 1398, 172 USPQ 530 (CCPA 1973); *In re Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re DeFano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1965). In the case of a small genus such as the halogens, which consists of four species, a reduction to practice of three, or perhaps even two, species might show possession of the generic invention, while in the case of a genus comprising hundreds of species, reduction to practice of a considerably larger number of species would be necessary. *In re Shokal*, *supra*.

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species he or she actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference. *In re Schaub*, 537 F. 509, 190 USPQ 324 (CCPA 1976).

715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations [R-2]

>

I. < WHO MAY MAKE AFFIDAVIT OR DECLARATION

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **>If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be

signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.<

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

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II. < FORMAL REQUIREMENTS OF AFFIDAVITS AND DECLARATIONS

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits.

37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

715.05 U.S. Patent or Application Publication Claiming Same Invention [R-2]

When the reference in question is a noncommonly owned U.S. patent or patent application publication claiming the same invention as applicant and its publication date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131. If the reference is claiming the same invention as the application and its publication date is less than 1 year prior to the presentation of claims to that invention in the application, this fact should be noted in the Office action. The reference can then be overcome only by way of interference. See MPEP §§ 2306-2308. If the reference is *>a U.S. patent which claims< the same invention as the application and its *>issue< date is ** more >than 1 year< prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b)>(1)< should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.).

>If the reference is a U.S. application publication under 35 U.S.C. 122(b), or a WIPO publication on an international application filed on or after November 29, 2000, which claims the same invention as the application being examined and its publication date is more than 1 year prior to the presentation of claims to that invention in the application being examined, a rejection of the claims of the application (being examined) under 35 U.S.C. 135(b)(2) should be made only if the application being examined was filed after the publication date of the reference.<

Form paragraph 23.14 or 23.14.01 may be used when making a rejection under 35 U.S.C. 135(b).

¶ 23.14 Claims Not Copied Within One Year of Patent Issue Date

Claim [I] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. [2] was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that the applica-

tion of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

¶ 23.14.01 Claims Not Copied Within One Year of Application Publication Date

Claim [I] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which [2] was published under 35 U.S.C. 122(b). See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

Examiner Note:

1. In bracket 2, insert the publication number of the published application.
2. This form paragraph should only be used if the application being examined was filed after the publication date of the published application.

Where the reference and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the reference are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims. *In re Clark*, 457 F.2d 1004, 173 USPQ 359 (CCPA 1972); *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Wagenhorst*, 62 F.2d 831, 16 USPQ 126 (CCPA 1933).

If the application (or patent under reexamination) and the domestic reference contain claims which are identical, or which are not patentably distinct, then the application and patent are claiming the "same patentable invention," defined by 37 CFR 1.601(n) as follows:

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A."

As provided in 37 CFR 1.601(i), an interference may be declared whenever an examiner is of the opinion that an application and a reference contain claims for the "same patentable invention." An applicant who is claiming an invention which is identical to, or obvious in view of, the invention as claimed in a domestic patent or patent application publication cannot employ an affidavit under 37 CFR 1.131 as a means for avoiding an interference with the reference. To allow an applicant to do so would result in the issuance of two patents to the same invention.

Since 37 CFR 1.131 defines "same patentable invention" in the same way as the interference rules (37 CFR 1.601(n)), the USPTO cannot prevent an applicant from overcoming a reference by a 37 CFR 1.131 affidavit or declaration on the grounds that the reference claims applicant's invention and, at the same time, deny applicant an interference on the grounds that the claims of the application and those of the reference are not for substantially the same invention. See *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979). Where, in denying an applicant's motion in interference to substitute a broader count, it is held that the limitation to be deleted was material for the opponent patentee, this constitutes a holding that the proposed count is for an invention which is not the "same patentable invention" claimed by the reference. Therefore, the applicant may file an affidavit or declaration under 37 CFR 1.131 to overcome a prior art rejection based on the reference. *Adler v. Kluver*, 159 USPQ 511 (Bd. Pat. Int. 1968).

Form paragraph 7.58 (reproduced in MPEP § 715) may be used to note such a situation in the Office action.

715.07 Facts and Documentary Evidence [R-2]

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I. < GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the alle-

gations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

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II. < ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

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III. < THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in

support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, **>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing *Newkirk v. *>Lulejian<*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection.

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

For the most part, the terms "conception," "reasonable diligence," and "reduction to practice" have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

One difference is that in interference practice a reduction to practice requires a proof that a utility was

known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. *In re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); *In re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Form paragraph 7.59 or 7.63 (both reproduced in MPEP § 715) may be used where insufficient evidence is included in a 37 CFR 1.131 affidavit.

715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO

or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

715.07(b) Interference Testimony Sometimes Used

In place of an affidavit or declaration the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of 37 CFR 1.131 affidavit or declaration.

The part of the testimony to form the basis of priority over the reference should be pointed out. *Ex parte Bowyer*, 1939 C.D. 5, 42 USPQ 526 (Comm’r Pat. 1939).

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country

35 U.S.C. 104. *Invention Made Abroad.*

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) DEFINITIONS.—As used in this section—

(1) The term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

The 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104.

Under 37 CFR 1.131(a), which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act. Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131

before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

715.07(d) Disposition of Exhibits

Exhibits, such as those filed as part of an affidavit or declaration under 37 CFR 1.131, must comply with the requirements of 37 CFR 1.91 to be entered into an application file. Exhibits that do not comply with the requirements of 37 CFR 1.91 will be disposed of or returned to applicant at the discretion of the Office. See also MPEP § 608.03(a).

715.08 Passed Upon by Primary Examiner

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition. Such petitions are answered by the Technology Center Directors (MPEP § 1002.02(c)).

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

715.09 Seasonable Presentation

Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

- (A) prior to a final rejection;
- (B) before appeal in an application not having a final rejection; or
- (C) after final rejection and submitted
 - (1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or

(2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or

(3) under 37 CFR 1.129(a).

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action.

For affidavits or declarations under 37 CFR 1.131 filed after appeal, see 37 CFR 1.195 and MPEP § 1211.02.

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations.

715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode

Any affidavits or declarations submitted under 37 CFR 1.131 and the accompanying evidence must be reviewed carefully by the examiner in order to determine whether they show that the claimed invention was "in public use" or "on sale" in this country more than one year prior to the effective filing date of the application, which acts constitute a statutory bar under 35 U.S.C. 102(b). Although the rejection based on the reference(s) or activity sought to be antedated may actually be overcome by such an affidavit or declaration, the effect of the applicant's prior "public use" or "on sale" activities may not be overcome under 37 CFR 1.131. See MPEP § 2133.03 regarding rejections based on "public use" and "on sale" statutory bars.

Where the 37 CFR 1.131 evidence relies on an embodiment of the invention not disclosed in the application, the question of whether the application includes the "best mode" must be considered. However, a "best mode" rejection should not be made unless the record, taken as a whole, establishes by a preponderance of the evidence that applicant's specification has not set forth the best mode contemplated by the inventor of carrying out the invention. See MPEP § 2165 - § 2165.04 regarding the best mode requirement of the first paragraph of 35 U.S.C. 112.

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